

REMARKS

Even though Applicants do not believe the positions taken by the Examiner about certain aspects of the claims are valid, the foregoing amendments have been made to more explicitly recite those aspects which were previously implicit. Basis for the changes can be found in paragraphs [0002] and [0003], as well as elsewhere in the application.

The current Office Action was issued in order to change the basis for the rejection over the Krishnan '646 patent from § 102 to § 103, even though the Appeal Brief considered the possibility of a § 103 rejection and set forth the reasons that the rejection was not valid. Accordingly, the Appeal Brief fully considered all of the current rejections and set forth reasons why none were valid. In response to each of the rejections in the current Office Action, therefore, the arguments set forth in the Appeal Brief are hereby incorporated by reference as if fully set forth herein.

In light of some of the comments made in the current Office Action, the Examiner is respectfully requested to consider the Appeal Brief traversal supplemented by the following comments.

On several occasions, an assertion is made in the Office Action that "Applicants submit evidences and state on the record that none of the nonionic surfactants of the known classes of acetylenic glycols, ethoxylated glycols has a hydrophilic/lipophilic balance of about 8-20". Applicants never submitted such evidence or made such statement.

On several occasions, reference was made to the "value" of an allowed claim or patent. However, the function of the Patent Office is to determine whether the

claims cover novel, unobvious and useful subject matter and the "value" to the Applicant of whatever may be allowed is not a matter of concern to the PTO.

The reference to "self-dampening" and "having a hydrophilic/lipophilic balance of about 8-20" is not a "property of a material" as alleged nor can it be considered inherent for the reasons set forth in the Appeal Brief. For instance, whether a composition is self-dampening is a function of its composition. The language in the Office Action appears to consider both phrases as if they apply to any and all compositions or surfactants while the evidence of record shows that not all compositions are self-dampening and not all surfactants have the required HLB. When the formulation and surfactant is as set forth in the instant claims, the composition is self-dampening.

The assertion that it would be obvious "to go out and select" any nonionic surfactant with a "reasonable expectation" the resulting composition would be self-dampening has no basis in fact and is also the application of an "obvious to try" standard, which is improper and insufficient under § 103.

The suggestion in the second paragraph on page 5 of the Office Action does not make sense in that the claimed method is based on use of the recited composition rather than some unstated additional material. The third paragraph on this page violates the rule that all teachings of a reference need to be considered.

The Declaration establishing that the surfactant of Krishnan, Example 1, had an HLB of less than about 8 which was submitted in the parent application is submitted herewith to complete the record. The Examiner will note that the Declaration explicitly states that a soap is not a conventional additive in lithographic inks. Also, in light of observations made in the Examiner's Answer in the parent case, it is pointed out that

U.S. 05-3586 batch # 509034 does not contain a Wasilewski tall oil fatty acid of soap but rather was a material used to formulate the compositions set forth in that Declaration.

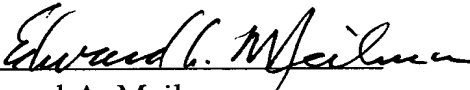
Finally, the statement on page 11 of the Office Action that to the effect that Applicants urge that the Wasilewski ink composition does not have a property of "self-dampening" is not understood. Applicants never made such a suggestion and quite to the contrary, have pointed out that the Wasilewski composition does have that property but only because of the presence of the tall oil fatty acid of soap. Wasilewski explicitly so states.

In light of the arguments presented in the Appeal Brief with the additional comments provided above, it is respectfully submitted that all of the prior art rejections should be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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